REMARKS

Remark 1:

It is noted that Claims 1-3 and 7-11 are rejected under 35 U.S.C. § 103 as being unpatentable over Yavitz et al. (U.S. Pat. No. 6,312,450) in view of Rodgers et al. (U.S. Patent No.6,455,501).

Applicant submits it is well settled that in order for references to be properly combined under 35 U.S.C. 103, there must be a teaching in at least one of the references to suggest that the disclosure of any of the other references could be modified to produce the Applicants' claimed invention. *ACS Hospital System, Inc. v. Montefiore Hospital et al., 221 U.S.P.Q. 929 (Fed. Cir. 1984); Orthopedic Equip. Co. v. U.S., 217 U.S.P.Q. 193 (Fed. Cir. 1983).* Additionally, absent some suggestion or incentive, the teachings of references may not be combined. *ACS, supra, 221 U.S.P.Q. 933, In re Rinehart, 531 F. 2d 1048, 189 U.S.P.Q. 143 (C.C.P.A. 1976).*

Applicant believes that Rodgers et al. teaches *away from* the claimed invention. In particular, Rodgers et al. is directed to treatment of wounds, i.e., "lacerations or openings" (column 1 line 19). This is inconsistent with the teaching of the present invention, in which the "wound healing composition" is used on tissue which has not been damaged. Since it is an objective of the present invention to treat tissue with electromagnetic energy without causing damage to the dermis, it would not be "*obvious*" to couple such treatment with the application of a wound healing composition to the skin, in order to improve collagenesis in the skin.

While the techniques and apparatus of the prior art are used on tissue which clearly has been damaged, wounded, lacerated and/or opened, the present invention is not even directed to treatment of wounded or damaged tissue. Applicant believes, therefore that Rodgers et al. teaches away from using a wound-healing composition, and also teaches away from combining any other reference having a

disclosure of a treatment of damaged, wounded, lacerated or opened tissue.

Remark 2:

A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Examiner will not, in particular, that the independent claims are directed to not just methods of treating skin, but also methods of treating acne scars, photodamaged skin and wrinkled skin. Examination of the Rodgers patent reveals that it is not directed to treatment of acne scars, photodamaged skin or wrinkles. Rodgers et al. has not a single reference or citation to such treatments and procedures.

It would not be obvious to combine the teachings of Rodgers et al. with the teachings of Yazits et al. to obtain the subject matter in pending Claims 7, 8 or 9.

Therefore it is respectfully submitted that Rodgers et al. is not relevant to the present invention.

Remark 3:

As for the proposed combination of references cited by the examiner, it is respectfully submitted that since none of the references in the combination teaches the distinctive features of applicant's invention as defined in the amended and the new claims, any hypothetical construction produced by this combination would not lead to applicant's invention.

It is respectfully submitted that the combined teachings of the references applied by the Examiner fail to disclose or even suggest the subject matter of the claims at issue. That a prior art reference could

be modified to form the claimed structure does not supply a suggestion to do so. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

In view of these considerations, it is respectfully submitted that the rejection of the amended and new claims should be considered as no longer tenable and should be withdrawn. The pending amended and new claims should be considered as patentably distinguishing over the art and should be allowed.

Remark 4:

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned.

Remark 5: (NO NEW MATTER)

Applicant submits that the amendments presented herein present no new matter. All of the devices, systems, methods and/or compositions claimed herein are taught in the Drawings, Specification, Claims and Abstract and other portions of the Application as originally filed.

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CONCLUSION

Applicant respectfully submits that for all the foregoing reasons, the claimed subject matter describes patentable invention. Furthermore, Applicant submits that the specification is adequate and that the claims are now in a condition for allowance. No new matter has been entered.

Applicant hereby respectfully requests Examiner to withdraw the cited references as anticipating or obviating prior art, enter these amendments, find them descriptive of useful, novel and non-obvious subject matter, and authorize the issuance of a utility patent for the truly meritorious, deserving invention disclosed and claimed herein.

Without further, Applicant does not intend to waive any claims, arguments or defenses that they may have in response to any official or informal communication, paper, office action, or otherwise, and they expressly reserve the right to assert any traverse, additional grounds establishing specificity and clarity, enablement, novelty, uniqueness, non-obviousness, or other patentability, etc.

Further, nothing herein shall be construed as establishing the basis for any prosecution history or file wrapper estoppel, or similar in order to limit or bar any claim of infringement of the invention, either directly or under the Doctrine of Equivalents.

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Respectfully submitted,

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Dated: October 21, 2005

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CERTIFICATE OF MAILING

I hereby certify that this paper and the documents attached hereto are being deposited in a postage prepaid, sealed envelope with the United States Postal Service using First Class Mail service under 37 CFR 1.08 on the date indicated and is addressed to "Commissioner for Patents, Virginia 22313-1450". Signed: _____.
Date Mailed: October 21, 2005